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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,916	10/29/2003	John Gerard Speare	13768-449	9720
47973	7590	12/21/2004		
WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			EXAMINER COLIN, CARL G	
			ART UNIT 2136	PAPER NUMBER

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,916

Applicant(s)

SPEARE ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/29/03. 6) ☐ Other:

DETAILED ACTION

1. Pursuant to USC 131, claims 1-44 are presented for examination.

Claim Objections

2. **Claims 14, 28, 36, and 44** are objected to because of the following informalities: there is a typo error on the "server". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3.1 **Claims 1-4, 7-8, 11-13, 15-18, 21-22, 25-27, 29-31, 34, 35, 37-39, and 43**, are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,775,772 to **Binding et al**.

3.2 **As per claims 1, 12, 15, 26, 29, 35, 37, and 43, Binding et al** discloses in a messaging system comprising a rights management server that controls the type of operations principals can perform on protected content and a message server that receives messages and makes them available to principals or their agents, a method of pre-licensing content subject to rights management in order to allow a principal access to the content when the principal does not have access to the rights management server, the method comprising acts of: receiving, by the message server, a message which is subject to rights management in that access to at least a part of the message is controlled through a rights management server, for example (see column 15, lines 15-36); receiving, by the message server, parameters that meets the recitation of a publishing license for use in identifying the message to the rights management server, for example (see column 15, lines 25-50); requesting, by the message server on behalf of one or more principals, at least one use license for allowing the one or more principals access to the message, wherein the request includes the publishing license to identify the message to the rights management server, for example (see column 15, lines 30-36); and receiving, by the message server on behalf of the one or more principals, the at least one use license so that the one or more principals may access the message without having to request the at least one use license from the rights management server, for example (see column 15, lines 15-63).

As per claims 2, 16, and 38, **Binding et al** discloses the limitation of wherein the at least a part of the message controlled through the rights management server is encrypted, and wherein the use license comprises a content key used in decrypting the part of the message that is encrypted, for example (see column 15, lines 15-36 and 45-63). **Binding et al** discloses other cryptographic embodiments are described in columns 9 and 10, for instance keys can be exchanged by parties (see column 10, lines 55-67).

As per claims 3 and 17, **Binding et al** discloses the limitation of wherein the part of the message that is encrypted is at least one of a protected contact, protected document, protected calendar item or protected meeting request, for example (see column 15, lines 15-63).

As per claims 4, 18, and 39, **Binding et al** discloses the limitation of wherein the act of requesting at least one use license further includes sending an authentication to the rights management server to verify that the message server has the authority to obtain the at least one use license on behalf of the one or more principals, for example (see column 15, lines 15-63).

As per claims 7, 21, and 30, **Binding et al** discloses the limitation of wherein the publishing license includes a reference to the one or more principals such that when the message server requests the at least one use license, the rights management server may validate that the one or more principals are intended to have access to the message, for example (see column 15, lines 20-45).

As per claims 8, 22, and 31, Binding et al discloses the limitation of wherein the publishing license further includes at least one rights expression that limits the types of operations the one or more principals are allowed to perform on the message, for example (see column 21, lines 18-29).

As per claims 11, 25, and 34, Binding et al discloses the limitation of wherein the rights expression includes an expiration feature, which limits at least one of the number of times or a time period the at least one rights expression is available, for example (see column 5, lines 10-22).

As per claims 13 and 27, Binding et al discloses the limitation of wherein the publishing license further comprises one or more of a hash used to verify the message has not changed and a signing by the rights management server used to verify that the publishing license is valid, for example (see column 9, line 63 through column 10, line 12).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

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which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 5, 14, 19, 28, 36, 40 and 44**, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,775,772 to **Binding et al**.

4.2 **As per claims 5, 14, 19, 28, 36, 40 and 44**, claims 5, 19, and 20 disclose the same inventive concept as claim 1 except for requesting multiple use licenses to allow access of the message on multiple machines. Although **Binding et al** discloses a detailed description of the invention with respect to one client and server, **Binding et al** also substantially teaches that the server is connected to various computers or workstations (intranet extranet etc.) and can be easily implemented to different network environment, therefore the invention is not limited to a single use license request, for example (see column 6, line 14 through column 8). **Binding et al** suggests a server providing services and responding to requests on behalf of multiple principals wherein messages can be accessed on different machines (column 8, lines 5-38). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the method of **Binding et al** to have the message server requests multiple use licenses on behalf of the one or more principals so that the one or more principals may access the message on multiple machines as suggested by **Binding et al**. This modification would have been obvious because one skilled in the art would have been motivated as a design choice by the suggestions provided by **Binding et al** so as to control access of plurality of users, for example (see column 8, lines 5-38 and column 15, lines 40-45).

5. **Claims 6, 9-10, 20, 23-24, 32-33, and 41-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,775,772 to **Binding et al** in view of US Patent 6,820,063 to **England et al**.

5.1 As per claims 6, 9-10, 20, 23-24, 32-33, and 41-42, **Binding et al** substantially teaches the claimed method of claim 1. **Binding et al** does not explicitly disclose storing the use license separate from the message. **England et al** in an analogous art teaches restriction of use license and also teaches right to access or copy, store a content or a particular file wherein the at least one use license is stored by the server separate from the message in order to add security and control access to the storage of keys, for example (see column 19, lines 55-61 and column 17, lines 2-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Binding et al** to have at least one use license stored by the server separate from the message as suggested by **England et al**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **England et al** so as to add security and control access to the storage of keys.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses limited access to content where one or more principals does not

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need to request the use license from the server. Many of the claimed features are disclosed in these disclosures.

US Patents: 6,643,774 McGarvey 6,205,480 Broadhurst et al
6,385,728 DeBry 6,487,599 Smith et al.

6.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

December 16, 2004

G. Moise
ENCLOSURE
PRI. EXAMINER